

REMARKS

Claims 1-20, 23, 24, 27 and 28 which are directed to temporarily protecting a portion of a surface which is to be coated are currently pending. Claims 21, 22, 25 and 26 which are directed to compositions useful in such method have been withdrawn.

New claims 29 and 30 have been added and are directed to the removal of the masking material, which temporarily protects the portion of the surface to be coated, with water. New claims 31 and 32 have been added and are directed to the removal of the masking material with pressurized water.

The Examiner has withdrawn his rejection claim 19 under 35 USC 112, second paragraph.

The Examiner has withdrawn his rejection of claims 1, 2, 11, 12, 23 and 24 under 35 USC 102(b), as anticipated by Van Winckel and claims 6-10, 16-20, 27 and 28 under 35 USC 103(a) as being obvious in view of Van Winckel.

The Applicants thank the Examiner for reconsidering and withdrawing the above rejections.

The Examiner continues to reject claims 27 and 28 under 35 USC 112, first paragraph, for failure to comply with the written description requirement. This rejection is based on the term "solely with water". The Examiner argues that there is no issue with the word "water" but the issue is support for and indefiniteness of the word "solely". Since Applicant has not specifically defined 'solely', the Examiner has interpreted this

term according to its ordinary meaning: 'without another; to the exclusion of all else'. (The Examiner cites Merriam-Webster's Collegiate Dictionary, 10th Edition, © 1998 by Merriam Webster, Inc., p. 1118). The Examiner states that the Applicant intends to distinguish his claims from Roberts, which requires a masking coating that must be removed with a specific alkaline aqueous solution comprising a dialkylaminoalkanol by claiming masking coatings that can be removed "solely with water", i.e. without the dialkylaminoalkanol required by Roberts. That is not the point. It is true that Applicant has pointed out that one advantage of his invention is that surfactants, solvents, etc. which are required to remove the prior art masking compositions, are not necessary to remove applicants masking coatings. (See Applicants arguments on pages 8 and 4 of the previous Amendment After Final Rejection).

However, the problem is whether Applicant can provide support for the term "solely" and whether the inclusion of such term makes claims 27 and 28 indefinite.

It is submitted that the disclosure at lines 29-33 of page 6, lines 7-4 of page 7, lines 11-13 of page 14 and 11-21 of page 11 of the specification supports the term "solely with water". There is no other element included in these disclosures. Moreover, these disclosures would be clear to one skilled in the art to refer "solely to water", i.e. these disclosures would exclude surfactants, solvents, the dialkylaminoalkanol of Roberts, etc. However, despite the Examiner's argument that "solely with water" would exclude tap water, distilled water, and deionized water, it is believed that to one of ordinary skill "solely with water" would include all of the above variations of water but would exclude elements such as

surfactants, solvents, etc. The person of ordinary skill in the art would be a person that is concerned with painting cars and the like and removing the masking coatings without having to disposed of a wash solution containing elements other than water. To such a person, tap water, deionized water, distilled water would be equivalent, i.e. none of these would require special handling and/or disposal techniques that are required for solvents, surfactants, etc.

Nevertheless, the Applicant has added claims 29 and 30 to require the masking material is removed with "water". Claims 31 and 32 require that the masking material may be removed with "pressurized water."

The Examiner has maintained his rejection of claims 1-3, 6, 7, 9-13, 16, 17, 19, and 20 under 35 USC 103(a) as being unpatentable over Van Winckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A). The Applicant argued in the previous amendment that there is no motivation the combine Van Winckel and Roberts.

The Applicant believes his arguments regarding lack of motivation to combine Van Winckel and Roberts are correct and argues the Examiner to reconsider this rejection.

Despite the Applicant's argument regarding the lack of motivation to combine Van Winckel and Roberts, the Examiner argues that:

"The elements of Applicant's claims taught by both Wan Winckel and Roberts are clearly set-forth in the Office Action mailed

08/13/03. Consequently, this argument is not persuasive. Furthermore, both Van Winckel and Roberts disclose removable, temporary, protective coating compositions (i.e., masking compositions). Since Van Winckel suggests the use of an acrylic emulsion as a masking composition and Roberts teaches a specific acrylic emulsion masking composition, one of ordinary skill would have been motivated by the desire and expectation of utilizing the composition of Roberts to successfully provide a temporary, removable, protective coating according to the method of Van Winckel."

It is believed that Roberts does not suggest the use of his coating as a masking coating as suggested by the Examiner. The coating disclosed by Roberts is utilized as a temporary coating to protect metal and painted surfaces from weather, grease, tar, insect droppings, graffiti, etc. However, Roberts does not suggest that his coating may be utilized in a masking operation wherein the surface not covered by the masking material is coated with a coating compound.

The Applicant argued that there is no suggestion that the acrylic copolymer of the masking material can be neutralized and solubilized as claimed in claims 6, 7, 16 and 17. Thus, even if the Examiner is correct in his argument that the invention, as claimed, is obvious in view of the combination of Van Winckel and Roberts, in certain claims, claims 6, 7, 16 and 17 are clearly patentable since Roberts does not disclose a copolymer that is solubilized by the added alkali. The Examiner's

response to this argument regarding the separate patentability of claims 6, 7, 16 and 17 was that the "examiner disagrees as Roberts teaches both the polymer, neutralizing agent, and final pH as disclosed by applicant. Absent evidence to the contrary, it is the examiner's position that solubilization of the polymer would necessarily result from neutralizing the polymer according to Roberts."

Since it is not disclosed by Roberts that any of his polymers are water soluble, it does not matter whether the neutralizing agent or the final pH are the same as disclosed by the Applicant. In an acrylic copolymer, as disclosed by Roberts, there must be sufficient hydrophilic groups, e.g., neutralized groups to dissolve to copolymer. For example, small amounts of copolymerized acrylic acid will not solubilized an ethylacrylate-acrylic acid copolymer no matter what degree of neutralization is obtained. Moreover, Roberts preferably requires partial neutralization of the dissolved polymers. (See from Column 2, line 63, to Column 3, line 9 of Roberts). Finally, as pointed out in the previous amendment, Roberts formulates his coatings so that they are unaffected by water (See column 10, lines 15-24 and Table 2 of Roberts). As a result, it is clear that Roberts' polymers do not meet the limitations of pending claims 6, 7, 16 and 17, in that they are not solubilized by the added alkali.

The Examiner has also taken issue with the Applicant's comments on removing the masking composition of the present invention with pressure washing. (This issue is now more important since newly-added claims 31 and 32 specifically claim removing the masking composition with pressurized water). The Examiner argues that:

"Pressure washing relies on a physical interaction between the mechanical force of the applied water and the coating. While Roberts teaches that the adhesive forces between the coating will not be affected by a chemical interaction with water (hence the need for a chemical reaction with an alkaline solution) the reference is silent with respect to high-pressure mechanical forces. Since pressure washing is well-known means of removing a coating from a surface, and there is no evidence of record that the coating of Roberts would not yield to such mechanical forces, it remains the examiner's position that it would have been obvious to remove Roberts' coating via pressure washing." (Emphasis added)

Thus, the Examiner is arguing that although the reference is silent regarding whether Roberts' water resistant coating may be removed by pressurized water, the Examiner may, himself, supply the missing element, i.e. pressurizing water, to determine it is obvious to remove Roberts' coating with pressurized water. This is clearly incorrect.

The Examiner has maintained his rejection of certain claims for obviousness under 35 USC 103(a) over the aforesaid combination of Van Winckel and Roberts, further in view of a third reference.

As to these rejections, the Applicant continue to rely on his arguments as set forth in the previous amendment.

It is believed, in view of the above, all of the claims are in condition for allowance. Therefore, the Examiner is asked to reconsider and withdraw his rejection and pass the claims to issue.

Respectfully submitted,

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